

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)



Applicant's or agent's file reference HARD1.063VPC	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US 03/22656	International filing date (day/month/year) 16.07.2003	Priority date (day/month/year) 16.07.2002
International Patent Classification (IPC) or both national classification and IPC B32B13/02		
Applicant JAMES HARDIE RESEARCH PTY. LIMITED et al		

- This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
- This REPORT consists of a total of 6 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

- This report contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application

Date of submission of the demand 10.02.2004	Date of completion of this report 23.08.2004
Name and mailing address of the International preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Schweissguth, M Telephone No. +49 89 2399-2069 

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US 03/22656

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-13 as originally filed

Claims, Numbers

1-70 as originally filed

Drawings, Sheets

1/7-7/7 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US 03/22656

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	2-17,19-22,24,25,27-42,44-55,57-70
	No: Claims	1,18,23,26,43,56
Inventive step (IS)	Yes: Claims	
	No: Claims	2-17,19-22,24,25,27-42,44-55,57-70
Industrial applicability (IA)	Yes: Claims	1-70
	No: Claims	

2. Citations and explanations

see separate sheet

Prior art:

- D1: WO 95 11357 A (SEAL COSTRUZIONI S R L ;VALENTE CORRADO (IT)) 27 April 1995 (1995-04-27)
D2: DE 199 38 806 A (SCHULTZE KRAFT ANDREAS) 22 February 2001 (2001-02-22)
D3: US-A-5 397 631 (GREEN GEORGE W ET AL) 14 March 1995 (1995-03-14)
D4: WO 97 19810 A (NESITE S R L) 5 June 1997 (1997-06-05)

Multiple independent claims:

An essential point for the Examining Authority, either in the international or regional European phase is the limitation of the number of independent claims in one category. Accordingly, in the present case a lack of clarity with regard to the claimed subject-matter arises from the number of independent product claims 1, 18, 43 and method claims.

Independent claim 1:

Analyses of features in view of prior art D1:

Document D1 discloses a panel comprising an aerated concrete core (1), a finishing layer of cement mortar on each side (2 and 3) and a reinforcing net within the finish layers (4). In contrast, claim 1 recites fiber cement, not aerated concrete.

Analyses of features in view of D4:

D4 refers in claim 1, line 2 to a cement containing polymeric fibers, covered with a sheet of aluminum. Since independent claim 1 does not specify the "finish layer" such aluminum layer as disclosed in D4, claim 1, line 3 may be regarded as a finish layer. In other words, any further layer may be considered as such finish layer since this layer is not further characterised in the claim.

Present claim 1 further specifies a protective layer. Again the layer has been described by way of its function that is a protective function. However, such function may also be fulfilled by the layers disclosed in D4, claim 2, lines 3 and 4 such as a layer of quality material such as wood, carpeting, ceramics, stone, or equivalent materials.

Accordingly, the subject-matter of present claim 1 lacks novelty over the disclosure of document D4.

Present claim 1 refers to a number of items which do not contain any information how the desired effect is achieved. By contrast, the protective layer is said to protect the finish layer from damage in storage, transport, and handling. However, no feature in claim 1 may be examined and it remains unclear from the wording of this claim which characteristic may be responsible for the protecting effect.

The same situation arises from the fact the protective layer resists tearing on removal and that no residue rests on the finish layer when removing the protective layer.

Accordingly, few items remaining in claim 1, as analysed above. The subject-matter of claim 1 therefore lacks novelty. Corresponding problems arising from further claims 18, 23, 26, 43 and 56.

Understanding of feature "removable":

It appears to the IPEA that any layer applied as protective layer is removable per se. Differences may occur in the method of removing such layers. Therefore, this item does not contribute to the analyses as distinguishing feature.

Further dependent claims:

Claims 2 to 5 deal with adhesives and their characteristics. To those skilled in the art D4 shows the use of various adhesives in connection with cement and polymeric fibers wherein layers are bonded with an adhesive layer.

Claims 6, 7, 8 refer to a protective prefinished fiber cement product of claim 1, wherein the protective layer comprises a polymeric film. Such polymeric film is disclosed from document D2, col. 6, claims 1 and 2, wherein a polyester is used for the finish of a fiber cement product. The use of polyethylene according to claim 8 appears also to be rendered obvious from this disclosure.

Dependent claims 9 to 17 refer to constructional variations and appear to be obvious to those skilled in the art.

All further independent claims:

All further independent claims refer essentially to the same items as already dealt with under the point referring to claim 1. Accordingly, those claims shall also be considered as being not novel over the disclosure of document D1.

The assembly according to claim 18 appears also to be common knowledge to those skilled in the art since the stack of a plurality of plates is a common method of storage such elements.

Accordingly, therefrom dependent claims lack the same deficiencies as claims 2 to 17 already analysed above.

Reference signs:

The present set of claims is not accompanied with reference signs. Accordingly, the understanding of the present subject-matter is complicated. When entering the European regional phase reference signs should be joined to the corresponding characteristics.

Spirit and scope of the present application page 13, last paragraph:

If the European regional phase is entered such paragraph should be deleted from the description.